



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,279	02/13/2001	Nitin Nayak	YOR9-2000-0574US1	9443
30743	7590	06/21/2006	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/781,279		NAYAK ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	JAGDISH PATEL		3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 4/11/06.

#### ***Response to Amendment***

2. Claims 1 and 4 have been amended and new claims 9-11 have been added.
3. The specification has been amended as per request.

#### ***Response to Arguments***

3. Applicant's arguments with respect to the Carpenter reference have been considered. Accordingly, and further in consideration of Declaration under 37 CFR §131 the prior art rejections of claims 1, 2 and 4 over the Carpenter reference have been withdrawn.

However, upon further consideration, the pending claims have been found non-statutory under 35 USC §101 as explained in detail in the following paragraphs. The claims are rendered indefinite under 35 USC 112, second paragraph.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3624

5. Claims 1,4 and 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites limitations "allowing a vendor to form a coalition.. ", " managing the request proposal tree ". These limitations render the claim indefinite because the allowing is an act of providing permission to so some act but it does not necessarily result in the act being carried out. In the instant claim, allowing a vendor to form a coalition may not result in actual formation of a coalition as claimed. Likewise the process of "managing" is broad and unclear because one of ordinary skill in the art cannot ascertain the specific acts involved in the process of managing.

Claim 1 recites limitation "the request proposal tree" which lacks positive antecedent basis. Note that the allowing step refers to "creating a request for a proposal tree". Furthermore this step of creating a request for a proposal tree is only recited as an intended function in conditional terms "allowing ..thereby creating a request for a proposal tree".

Claim 1 recites the limitation "by controlling access to contained information" . However, it unclear how this information related to any other limitation.

Claim 1 recites " selecting a preferred coalition from coalition alternates at each level of ..the tree". However, this feature lacks positive antecedent basis because the claim does not specify "coalition alternates at level of the request proposal tree" in the claim.

This analysis also applies to dependent claims 10-11, and claims 4-8.

### ***35 USC 101 Rejection***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention may be statutory subject matter if the invention meets the practical application requirement, i.e. the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

The aforementioned claims do not expressly or implicitly recite machine implementation. The steps of translating the request for proposal into demanded capabilities can be performed manually by reading the proposal, analyzing the requirements thereof and listing the capabilities required by the proposal. Similarly, the process of matching, generating, allowing, managing, selecting and aggregating are all process steps which can be performed by one more human entities. Therefore, the process steps are disembodied since no machine or computer implementation is recited. The claimed steps do not require transformation of any physical subject matter, such as an electrical signal, into a different state or thing. The computational steps of the aforementioned claims are directed to abstract idea of aggregating coalitions to respond to an initial request for proposal from a customer. Because the acts such as translating the request for proposal into demanded capabilities and matching the demanded capabilities with registered

Art Unit: 3624

vendor capabilities are performed manually, one cannot achieve “concrete and tangible” outcome of such manual acts.

Therefore, it is concluded that the claims fail to meet the “practical application” requirements under 35 USC §101 because they fail to produce “concrete, tangible and useful” result.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

6/14/06